

REMARKS

At the outset, the Examiner is thanked for considering the pending application. The Final Office Action dated December 21, 2010 has been received and its contents carefully reviewed.

Claims 1 and 14 are hereby amended. No new matter has been added. Claims 1-16 are currently pending. For the purposes of the Office Action mailed December 21, 2010, claims 8-13 have been withdrawn. Reconsideration of the pending claims is respectfully requested.

The Office Action rejects claims 1-3, 5-7, 14, and 15 under 35 U.S.C. 103(a) as being unpatentable over US Application Publication No. 2004/0106003 to Chen et al. ("Chen"). Applicants respectfully traverse this rejection.

The Examiner indicates that the selected species under examination requires substituents R1 to R4 to be hydrogen. Claims 1 and 14 have now been amended by deleting "hydrogen" as a species for R2 and R3. Accordingly, the rejection is rendered moot.

The applicant further provides the following remarks to the extent that the Examiner presents a similar rejection in the next office action.

Claim 1 recites, *inter alia*, "an electroluminescent device comprising . . . an electroluminescent element that includes a fluorescent 1,1'-binaphthyl derivative represented by Formula (I)." Claim 14 recites, *inter alia*, "an organic electroluminescent device comprising . . . a light emitting layer comprised of a 1,1'-binaphthyl derivative of Formula (I)" Chen fails to teach or suggest at least these features of claims 1 and 14 and thus cannot render obvious these claims or any claim dependent thereon.

Applicants incorporate by reference the arguments provided in their previous response to Office Action. To briefly reiterate, it has been a long standing principle that "the fact that a claimed species or subgenus is encompassed by a prior art genus is not sufficient by itself to establish a *prima facie* case of obviousness." M.P.E.P. 2144.08(II). The Office Action explicitly

admits that Chen does not exemplify a binaphthyl derivative wherein X is carbon and all R variables are hydrogen. See *Office Action* at p. 3. Nonetheless, the Examiner concludes that the compound described in the claims would have been obvious to one of ordinary skill in the art simply because it falls within the genus disclosed in Chen. *Id.* This conclusion is improper as it fails to establish a *prima facie* case of obviousness as required under *Graham v. John Deere* as explicitly explained in M.P.E.P. 2144.08.

The conclusory statement upon which the Office Action relies for obviousness is exactly what the case law and the M.P.E.P. admonish as being improper. In response to these arguments, the Examiner simply states she is not persuaded and repeats the rejection. This is also improper as it does not cure the deficiency identified above and in Applicants' previous response to Office Action.

According to M.P.E.P. 2144.08, an obviousness determination based on a reference that discloses a broad genus requires a four step analysis. The Examiner has to determine the scope of the prior art, ascertain the differences between the prior art and the claims in issue, determine the level of ordinary skill in the art, and evaluate any evidence of secondary considerations. *M.P.E.P. 2144.08.* Chapter 2144.08 describes in detail what each step in the analysis involves. This thorough analysis is imposed on the USPTO to explicitly avoid a finding of unpatentability based solely on having a species fall within a disclosed genus.

The Office Action rejection and the Examiner's response both fail to provide the required analysis necessary to present a *prima facie* case of obviousness. "Based on the evidence as a whole, . . . Office personnel should make express fact-findngs relating to the *Graham* factors, focusing primarily on the prior art teachings discussed above." *M.P.E.P. 2144.08(II)(A)(5)*. "The fact-findings should specifically articulate what teachings or suggestions in the prior art would have motivated one of ordinary skill in the art to select the claimed species or subgenus."

Id. The Office Action does not present any analysis of the physical and chemical properties of the structure, nor does it address the predictability of the technology and the number of species encompassed by the genus. While disclosure of a broad genus alone may not be sufficient to show non-obviousness, it is a factor that must be taken into account and there must be a reason provided in the Office Action as to why one of ordinary skill in the art would select the specific species under examination. Because the Office Action fails to address the above issues it fails to meet the burden of establishing a *prima facie* case of obviousness. Thus the Office Action is improper and should be withdrawn.

In view of the above, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-3, 5-7, 14, and 15. To the extent the Examiner decides to maintain the rejection, Applicants respectfully request that the Examiner provide a full analysis in accordance with the guidelines provided in M.P.E.P. 2144.08 and that the finality of the action be withdrawn to allow Applicants a proper opportunity to respond.

The Office Action further rejects claims 3 and 4 under 35 U.S.C. 103(a) as being unpatentable over Chen in view of JP Publication No. 11-302639 to Sato et al. ("Sato"). The Office Action further reject claim 16 under 35 U.S.C. 103(a) as being unpatentable over Chen in view of JP Publication No. 2002-324676 to Suzurisato et al. ("Suzurisato"). Applicants respectfully traverse these rejections.

Claims 3 and 4 ultimately depend on claim 1, and claim 16 ultimately depends on claim 14; thus these claims incorporate each and every element of the respective independent claims. As discussed above and in Applicants' previous response to Office Action, Chen fails to render at least claims 1 and 14 obvious. Neither Sato nor Suzurisato cure the deficiencies in Chen. Accordingly, the combined teachings of Chen and Sato cannot render obvious claims 3 and 4 for at least the same reasons as claim 1, and the combined teachings of Chen and Suzurisato cannot

render obvious claim 16 at least for the same reasons as claim 14. Applicants, therefore, respectfully request withdrawal of these rejections.

The application is in condition for allowance and early, favorable action is respectfully solicited. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at (202) 496-7500 to discuss the steps necessary for placing the application in condition for allowance. All correspondence should continue to be sent to the below-listed address.

If these papers are not considered timely filed by the Patent and Trademark Office, then a petition is hereby made under 37 C.F.R. §1.136, and any additional fees required under 37 C.F.R. § 1.136 for any necessary extension of time, or any other fees required to complete the filing of this response, may be charged to Deposit Account No. 50-0911. Please credit any overpayment to deposit Account No. 50-0911.

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